

REMARKS

1. Status of Claims

Claims 1-20 were pending in the Application. Applicants have amended claims 2-3, 9, 12-13 and 20 without prejudice or disclaimer. Applicants respectfully request entry of the above amendments and consideration of the enclosed remarks. Applicants submit that no new matter is added. Accordingly, claims 1-20 will remain pending in the application.

2. Objections to the Drawings

In section 8 of the Office Action, the Examiner objected to the Drawings. In order to expedite prosecution, Applicants submit Replacement Sheets 1/4 - 4/4 including amended FIG. 4 wherein box 430 includes profile data as supported at least at paragraph 0062. Applicants have also corrected the spelling of "receive." Accordingly, Applicants respectfully request that the Examiner withdraw the objection.

3. Objections to the Claims

In sections 10-11 of the Office Action, the Examiner objected claims 2 and 9 and associated dependent claims due to antecedent basis concerns. Applicants have amended claims 2 and 9 and respectfully request that the Examiner withdraw the objection.

4. Rejections Under 35 USC § 112

In section 13 of the Office Action, the Examiner rejected claim 20 under 35 U.S.C. § 112, second paragraph, as allegedly being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Applicants respectfully traverse the rejection, but have amended claim 20 without prejudice or disclaimer to expedite prosecution and respectfully submit that the

amended claims comply with 35 U.S.C. § 112. Accordingly, Applicants respectfully request that the Examiner withdraw the rejection.

5. Rejections under 35 USC § 103 (a)

In section 15 of the Office Action, the Examiner rejected Claims 11-13 under 35 U.S.C. 103(a) as allegedly rendered obvious by U.S. Patent No. 6,972,862 to Tang, et al. ("Tang '862") in view of U.S. Patent Application Publication No. 2003/0214681 by Bohan ("Bohan '681") in view of U.S. Patent No. 7,180,638 to Hou, et al. ("Hou '638") in view of U.S. Patent No. 6,502,756 to Fahraeus ("Fahraeus '756") and further in view of U.S. Patent No. 6,307,956 to Black ("Black '956").

Applicants respectfully traverse the rejection. Applicants initially respectfully traverse the purported motivation to combine all five of the cited references as stated. One of skill in the art would not be motivated to weave the teachings of the five cited references as suggested by the Examiner without resort to impermissible hindsight.

Tang '862 teaches a completely separate portable fax machine that generates and sends pen-based facsimile messages completely in a stand alone mode. There is specifically no suggestion of adding attachments to the facsimile messages. There is also therefore no suggestion of how to obtain and authorize access to any such attachments. In fact, since the system of Tang '862 is explicitly intended to provide a full portable facsimile machine, the combination suggested by the Examiner would not be suitable for the intended purpose stated by Tang, et al. Accordingly, the combination is improper and Applicants respectfully request that the rejection be withdrawn.

Bohan '681 does not teach or suggest a digital pointing instrument to compose a facsimile and as a main feature presents a copy of the composed facsimile for review on a computer screen display that could not be accomplished with a pen and paper interface. Additionally, none of the references teach or fairly suggest composing a facsimile using pen stroke to identify an attachment that is then appended to the facsimile message. Furthermore, none of the references teach or fairly suggest using pen strokes to determine authority to access an attachment that is then appended to the

facsimile message. For example, Bohan '681 describes navigating through a list of files located on the specific computing device and not a remote server.

One of skill in the art would not combine Hou '638 as suggested as it does not suggest digital pen input facsimile composition and there would be no need for referencing the attachment as taught in the instant application because the user of Hou '638 would merely navigate the computer file system to select the attachment as also shown in Bohan '681 using interactive file system navigation. Thus each of the cited references describing finding facsimile attachments teaches away from remote, pen-based identification of the attachments since they require navigation of a file system.

Applicants respectfully submit that the Examiner has not met the burden of providing a prima facie obviousness rejection since the Examiner has not provided any explanation as to why one of skill in the art would combine all five of the references. The rejection merely separately describes why certain subsets of the cited references are allegedly combinable.

Regarding amended claims 12-13, Applicants respectfully submit that the dependent claims are patentable over the cited references for at least the same reasons described with reference to the associated independent claim and any intervening claims.

Furthermore, Applicants respectfully submit that the cited references do not teach or suggest at least:

the processor is operative with the logic program to perform determining user identification data; and wherein requesting the at least one determined attachment includes using the user identification data to identify the location of the at least one determined attachment.

Accordingly, Applicants respectfully request that the Examiner withdraw the rejection to claims 11-13.

In section 16 of the Office Action, the Examiner rejected Claims 1, 2 and 6-7 under 35 U.S.C. 103(a) as allegedly rendered obvious by U.S. Patent No. 6,972,862 to Tang, et al. ("Tang '862") in view of U.S. Patent Application Publication No.

2003/0214681 by Bohan ("Bohan '681") and further in view of U.S. Patent No. 6,722,574 to Skantze, et al. ("Skantze '574").

Applicants respectfully traverse the rejection. Applicants initially respectfully traverse the purported motivation to combine the cited references as stated. One of skill in the art would not be motivated to weave the teachings of the cited references as suggested by the Examiner without resort to impermissible hindsight as described above with reference to the Tang '862 and Bohan '681 references.

With respect to Skantze '574, Applicants respectfully disagree with the Examiner's assertion that the reference teaches adding attachments to a facsimile message.

Applicants respectfully submit that the dependent claims are patentable over the cited references for at least the same reasons described with reference to the associated independent claim and any intervening claims.

Accordingly, Applicants respectfully request that the Examiner withdraw the rejection to claims 1, 2 and 6-7.

In section 17 of the Office Action, the Examiner rejected Claims 3-5 under 35 U.S.C. 103(a) as allegedly rendered obvious by U.S. Patent No. 6,972,862 to Tang, et al. ("Tang '862") in view of U.S. Patent Application Publication No. 2003/0214681 by Bohan ("Bohan '681") in view of U.S. Patent No. 6,722,574 to Skantze, et al. ("Skantze '574") and further in view of U.S. Patent No. 6,307,956 to Black ("Black '956").

Applicants respectfully traverse the rejection. Applicants initially respectfully traverse the purported motivation to combine the cited references as stated. One of skill in the art would not be motivated to weave the teachings of the cited references as suggested by the Examiner without resort to impermissible hindsight as described above.

Applicants respectfully submit that the dependent claims are patentable over the cited references for at least the same reasons described with reference to the associated independent claim and any intervening claims.

Furthermore, with regard to amended claim 3, Applicants respectfully submit that the cited references do not teach or suggest at least:

determining user identification data; and
wherein requesting the at least one attachment includes using the
user identification data and the attachment identifier to identify the location
of the attachment.

Accordingly, Applicants respectfully request that the Examiner withdraw the rejection to claims 3-5.

In section 18 of the Office Action, the Examiner rejected Claims 14-16, 19 and 20 under 35 U.S.C. 103(a) as allegedly rendered obvious by U.S. Patent No. 6,972,862 to Tang, et al. ("Tang '862") in view of U.S. Patent Application Publication No. 2003/0214681 by Bohan ("Bohan '681") in view of U.S. Patent No. 7,180,638 to Hou, et al. ("Hou '638") in view of U.S. Patent No. 6,502,756 to Fahraeus ("Fahraeus '756") in view of U.S. Patent No. 6,307,956 to Black ("Black '956") in view of U.S. Patent No. 6,722,574 to Skantze, et al. ("Skantze '574") and further in view of U.S. Patent No. 6,917,724 to Seder, et al. ("Seder '724").

Applicants respectfully traverse the rejection. Applicants initially respectfully traverse the purported motivation to combine all seven of the cited references as stated. One of skill in the art would not be motivated to weave the teachings of the seven cited references as suggested by the Examiner without resort to impermissible hindsight.

Applicants incorporate the objection to the cited reference combinations above and submit that there is no argument for combining all seven references together. Thus, a prima facie rejection has not been established.

Additionally, Seder '724 describes reading watermarks using digital cameras to reference a file and one of skill in the art would not look to Seder '724 to modify any of the preceding references. Seder '724 is not analogous art.

Furthermore, Applicants respectfully disagree with the Examiner's characterization of Skantze '574 on page 25 of the Office Action since it does not fairly teach or suggest attachment identifiers or attachments as claimed in the instant application. The referenced description quoted is not "analogous" to attachments and

“attachments” are not inherent in the reference. Seder ‘724 does not teach or suggest identifying an attachment using biometric data. With regard to claim 19, Applicants respectfully submit that the references to Seder ‘724 are not “analogous” to the elements discussed.

Applicants respectfully submit that the Examiner has not met the burden of providing a prima facie obviousness rejection since the Examiner has not provided any explanation as to why one of skill in the art would combine all seven of the references. The rejection merely separately describes why certain subsets of the cited references are allegedly combinable.

Applicants respectfully submit that the dependent claims are patentable over the cited references for at least the same reasons described with reference to the associated independent claim and any intervening claims.

Accordingly, Applicants respectfully request that the Examiner withdraw the rejection to claims 14-16, 19 and 20.

In section 19 of the Office Action, the Examiner rejected Claims 9-10 and 17-18 under 35 U.S.C. 103(a) as allegedly rendered obvious by U.S. Patent No. 6,972,862 to Tang, et al. (“Tang ‘862”) in view of U.S. Patent Application Publication No. 2003/0214681 by Bohan (“Bohan ‘681”) in view of U.S. Patent No. 6,722,574 to Skantze, et al. (“Skantze ‘574”) in view of U.S. Patent No. 6,307,956 to Black (“Black ‘956”) and further in view of U.S. Patent No. 6,917,724 to Seder, et al. (“Seder ‘724”).

Applicants respectfully traverse the rejection. Applicants initially respectfully traverse the purported motivation to combine all five of the cited references as stated. One of skill in the art would not be motivated to weave the teachings of the five cited references as suggested by the Examiner without resort to impermissible hindsight.

Applicants incorporate the objection to the cited reference combinations above and submit that there is no argument for combining all five references together. Thus, a prima facie rejection has not been established.

Additionally, Seder '724 describes reading watermarks using digital cameras to reference a file and one of skill in the art would not look to Seder '724 to modify any of the preceding references. Seder '724 is not analogous art.

Furthermore, Applicants respectfully disagree with the Examiner's characterization of Skantze '574 on page 29 of the Office Action since it does not fairly teach or suggest attachment identifiers or attachments as claimed in the instant application. The referenced description quoted is not "analogous" to attachments and "attachments" are not inherent in the reference. Seder '724 does not teach or suggest identifying an attachment using biometric data and does not suggest facsimile messages at all as suggested on page 30 of the Office Action.

With regard to claim 17, Applicants respectfully submit that the references to Seder '724 are not "analogous" to the elements discussed.

Applicants respectfully submit that the Examiner has not met the burden of providing a prima facie obviousness rejection since the Examiner has not provided any explanation as to why one of skill in the art would combine all seven of the references. The rejection merely separately describes why certain subsets of the cited references are allegedly combinable.

Applicants respectfully submit that the dependent claims are patentable over the cited references for at least the same reasons described with reference to the associated independent claim and any intervening claims.

Accordingly, Applicants respectfully request that the Examiner withdraw the rejection to claims 9-10 and 17-18.

In section 20 of the Office Action, the Examiner rejected Claim 8 under 35 U.S.C. 103(a) as allegedly rendered obvious by U.S. Patent No. 6,972,862 to Tang, et al. ("Tang '862") in view of U.S. Patent Application Publication No. 2003/0214681 by Bohan ("Bohan '681") in view of U.S. Patent No. 6,722,574 to Skantze, et al. ("Skantze '574") and in further view of U.S. Patent Application Publication No. 2002/0107885 by Brooks, et al. ("Brooks '885").

Applicants respectfully traverse the rejection. Applicants initially respectfully traverse the purported motivation to combine the references as stated above.

Claim 8 is patentable over the cited references for at least the reasons stated above with reference to the associated independent claim and any intervening claims.

Accordingly, Applicants respectfully request that the Examiner withdraw the rejection to claim 8.

Accordingly, Applicants respectfully request that the Examiner withdraw the rejection and submit that the invention as presently claimed in claims 1-20 is patentable and in condition for allowance.

6. Conclusion Of Remarks

For at least the reasons stated above, it is respectfully submitted that the claims of this application are in condition for allowance and early and favorable action thereon is requested.

If the Examiner believes that additional issues may be resolved by a telephone interview, the Examiner is respectfully urged to telephone the undersigned attorney for Applicant at (203) 924-3180.

7. Authorization

No fee is believed due with this Amendment. However, the Commissioner is hereby authorized to charge any additional fees which may be required for the response or credit any overpayment to the Pitney Bowes, Inc. Deposit Account Number 16-1885, Order No. F-521.

In the event that an extension of time or additional extension of time is required to make this response timely filed, the Commissioner is requested to grant a petition for that extension of time which is required to make this response timely. The Commissioner is hereby authorized to charge any fee for such an extension of time or credit any overpayment for an extension of time to the Pitney Bowes, Inc. Deposit Account Number 16-1885, Order No. F-521.

Respectfully submitted,

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